

PATENT

Application No. 10/726,389
Attorney Docket No. 067493-5015-US02
Former Docket No. A-70547-2; 468940-00071

REMARKS

Upon entry of the foregoing amendments, claims 1-22 are pending in the application, with claims 1 and 14 being the independent claims. Claim 13 has been amended to correct a typographical error. Support for the subject matter of the amended claims is contained in the application as originally filed. Because the foregoing changes introduce no new matter, their entry is respectfully requested.

Election of Species

In the Restriction Requirement mailed March 30, 2007, the Examiner required election of a species of supplemental component selected from the group consisting of air filters, fuel filters, an ion exchange column, a fan, a pump, a pump control chip, a metering valve, a metering pump, a membrane, a water absorbent, a carbon dioxide absorbent, and a methanol absorbent.

Applicant provisionally elects a carbon dioxide absorbent. This election is made with traverse. Dependent claims 3 and 18 recite the group of supplemental components from which the Examiner requires the election of a single species, including the elected carbon dioxide absorbent mentioned above. As discussed below, claims 3 and 18 are generic as they are Markush-type claims. All remaining claims are generic to supplemental components, including independent claims 1 and 14.

All claims are generic

The Examiner states that no claim is generic. Applicant strongly disagrees. MPEP 806.04(d) states that in general, a generic claim should require no material element additional to those required by the species claims. Claim 1 recites a removable fuel cell cartridge for a liquid fuel cell assembly comprising a container comprising a first chamber for fuel comprising at least one port for delivery of fuel to a fuel cell assembly; and a second chamber for one or more supplemental components, wherein said second chamber comprises at least two ports at least one of which communicates with said fuel cell assembly. Since claim 1 requires no material element additional to those required by the species of claim 3, claim 1 is generic. In particular, claim 1 is not limited to carbon dioxide absorbents but is generic to all supplemental components.

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Furthermore, Markush-type claims are considered generic. *See* MPEP 803.02 ("This subsection deals with Markush-type generic claims which recite a plurality of alternatively usable substances or members."); *see also* MPEP 806.04(e) ("a claim may encompass two or more of the disclosed embodiments (and thus be designated a *generic or genus claim*)"). Thus, Markush-type claims 3 and 18 are generic.

No serious burden.

A further requirement for proper restriction is that the Examiner must also explain why there would be a serious burden on the Examiner if restriction is not required. MPEP 803.01(I)(B) & (II); MPEP 808; MPEP 808.02. The Examiner is required to show by appropriate explanation that each invention has a separate classification, that each invention has a separate status in the art if they are classifiable together or that the inventions require search of different fields. MPEP 808.02.

The Examiner has not classified each species. He has not identified any groups of inventions and has not identified the class and subclass of any group. Therefore, the Examiner has not shown that each invention has a separate classification.

The Examiner also has not given any reasons why the claimed species have attained separate status in the art even if they were to be classified together. The Examiner has offered no evidence, such as patents, as to why the restricted species would have separate status in the art.

The Examiner has offered not explained why different fields of search would be necessary. Applicant notes that the Examiner's statement that "the species require a different search" is conclusory and offers no reasoning in support of the showing required by MPEP 803(II).

The Examiner therefore has not met the requirements set forth by the MPEP for establishing burden, i.e., showing separate classification, separate status in the art or a different field of search. In fact, nowhere in the Requirement for Restriction has the Examiner asserted that he would suffer a serious burden if restriction were not required, and thus the Examiner has not offered any explanation or reasons supporting an assertion of serious burden. Applicant notes that the Examiner must provide a clear and detailed

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record of the restriction requirement. MPEP 814 (citing *Geneva Pharms. Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1381, 68 USPQ2d 1865, 1871 (Fed. Cir. 2003) (original emphasis)).

The Examiner also has failed to show that he would suffer a serious burden if restriction were not required. Applicant thus respectfully requests that the Examiner withdraw the requirement for restriction.

At the very least, the Examiner must withdraw the restriction insofar as absorbents are concerned, namely, between a water absorbent, a carbon dioxide absorbent, and a methanol absorbent.


CONCLUSION

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extension of time or additional claims, and/or credit any overpayment to Deposit Account No. 50-0310 (Order No. 067493-5015-US02).

Respectfully submitted,

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By: 
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